

REMARKS

This is in response to the Office Action mailed April 9, 2001. Claims 1, 2 and 5 have been amended in light of Applicant's ongoing traverse of the restriction requirement. Applicant respectfully requests reconsideration of the restriction requirement for the reasons discussed below.

Restriction Requirement

The Examiner has maintained the restriction requirement, based on a contention that the apparatus as claimed can be used in a materially different process than that claimed.

Particularly, the Examiner states that using the "container for storing lens wafers" differs materially from the process claimed. That is clearly incorrect with respect to claims 1 and 3 - 9. All these claims are silent about how the container is used. Therefore, these claims cover all possible uses of the container, so that there is no use of the container that can be said to "differ" from what is claimed.

The Examiner's error was to cite MPEP 806.05(e), which pertains to claims directed to both a product and a process of using the product. Claims 1 and 3 - 9 on the other hand are "process of making" claims, not "process of using" claims. Accordingly, MPEP 806.05(f) applies, not MPEP 806.05(e).

According to MPEP 806.05(f), process and product inventions are distinct only if "the process . . . is not an obvious process of making the product and the process . . . can be used to make other and different products."

The Examiner has not made either showing. Indeed, with respect to method claims 1, 3, and 4, and apparatus claims 10 - 13, it is hard to imagine how she could show that it would not

be obvious, to achieve a container coated with titanium dioxide, to coat the container with titanium dioxide, or how it would even be possible to use a process of coating a container with titanium dioxide that would result in anything other than a container coated with titanium dioxide. It is clear that the inventions of claims 1 and 3 - 13 are not distinct according to MPEP 806.05(f).

Claim 2 has been amended to clarify that it recites a process of using a container, i.e., holding semiconductor wafers. Unlike claims 1 and 3 - 9, this is a “process of using claim.” Yet, the MPEP indicates that a restriction between claim 2 and the other claims is still improper.

Particularly, the application as originally filed contained (a) claims to a product (claims 10 - 13), (b) claims to a process of making a product (claims 1, 3 - 9), and (c) a claim (claim 2) to a process of using a product. Therefore, MPEP 806.05(i) (“Product, Process of Making, and Process of Using”) applies. Citing 37 CFR 1.141, MPEP 806.05(i) states “[i]f the process of making and the product are not distinct [which as shown above, they are not], the process of using may be joined with the claims directed to the product and the process of making the product *even though a showing of distinctness between the product and process of using the product can be made.*”

Therefore, it does not matter whether the Examiner can show an example of a process of using the product of claim 10 that is distinct from the process of claim 2. Regardless, the process of claim 2 may be joined with the other claims according to the MPEP. Therefore, claims 1 - 4 are all entitled to examination in the present application, and the restriction requirement with respect to these claims was clearly improper.

Turning to claims 5-9, if the Examiner wants to assert that these claims are distinct from claims 10-13, she must make the showing required by MPEP 806.05(f), i.e., that either “the

process . . . is not an obvious process of making the product and the process . . . can be used to make other and different products.” It is not clear how the Examiner would make such an argument. Claims 5 - 9 recite a process of making a product that includes coating a plastic container with a material or combination of materials that has selected properties of titanium dioxide (i.e., relatively hydrophylic and adapted to decompose organic molecules into gases). The product claims (10 - 13) all recite a container coated with titanium dioxide, which has the properties claimed for the material used in the process. The Examiner has not shown that the claimed process would be an obvious one for producing the product, or that containers coated with titanium dioxide are “other and different” from containers coated with relatively hydrophylic materials that are further adapted to decompose organic molecules into gases, so the restriction requirement with respect to claims 5 - 9 was also improper.

As there is not an adequate ground for restricting any of the claims, it was also improper to make the restriction requirement FINAL. Moreover, if a properly grounded restriction requirement is made in the future, it cannot be made FINAL until Applicant has had an opportunity to respond. Applicant therefore respectfully requests reconsideration of both the restriction requirement and its finality.

Section 102 Rejections

Claims 10 and 12 - 13 stand rejected as being anticipated by Nugent, Jr. et al., U.S. Patent No. 5,573,819 (“Nugent”). The Examiner states that Nugent discloses a container including a plastic material and further comprising a coating that includes titanium dioxide.

Nugent discloses titanium dioxide as being one of a number of “pigments”, which are one type of a number of types of “other additives,” for incorporation into “coating compositions”

which themselves are disclosed to be “a wide variety of polyepoxides used to react with polyamines.” The reference does not disclose titanium dioxide as the essential or only active ingredient of a barrier coating suitable for the purpose claimed, i.e., to decrease gas permeability.

Claim 10 has been amended to clarify that the coating consists essentially of titanium dioxide and therefore does not include other active ingredients, such as the “at least about seven percent by weight amine nitrogen” and the “hydroxyl group content of at least 6 percent by weight” disclosed in Nugent (Col. 2, lines 8 - 21).

Support for the amendment is found in the last paragraph of Page 5 of the specification, where a preferred form of the invention is described wherein a container is coated solely with titanium dioxide in gel form.

Claims 10 and 12 - 13 stand rejected as being anticipated by Matsubayashi et al., U.S. Patent No. 4,686,152 (“Matsubayashi”). The Examiner states that Matsubayashi discloses an apparatus comprising a plastic container coated with titanium dioxide.

Claim 10 has been amended to clarify that the container is a plastic container, rather than simply a container that includes some plastic layers. Support is found on Page 3 of the Specification which describes a preferred container which “is formed of a plastic material”

Matsubayashi, by contrast, discloses an iron foil which is laminated with a plastic material. Further, Matsubayashi does not provide any reason to believe that forming a coating consisting essentially of titanium dioxide on a plastic container would produce any benefit, since the purpose of the titanium dioxide is stated to be for corrosion resistance. Col. 10, lines 8 - 13.



It is submitted that claims 1 - 18 are in condition for allowance, and the Examiner is respectfully requested to pass this case to issue.



Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Garth Janke".

Garth Janke

Reg. No. 40,662

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